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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,913	02/23/2000	Robert Lane Cook	25791.02	3719

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HAYNES AND BOONE, LLP
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EXAMINER

BOMAR, THOMAS S

ART UNIT PAPER NUMBER

3672

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/510,913	COOK ET AL.	
	Examiner	Art Unit	
	Shane Bomar	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,6,8 and 12-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,8,22-33 and 38-41 is/are allowed.
- 6) ☒ Claim(s) 2,4,12-21,34-37 and 42-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/11/05, 5/12/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 44 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the inside diameter of the compressible annular member being substantially equal to the outside diameter of the thin wall section (see Figs. 14a-f), does not reasonably provide enablement for the inside diameter of the compressible annular member being substantially equal to the inside diameter of the thin wall section. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. It appears that the only way that the inside diameters of both the annular member and the thin wall section could be equal is if the annular member were to be attached only at the very tip of the thin wall section. This embodiment could not be found in the specification or the drawings.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the rejection under 35 U.S.C. 112, first paragraph, this claim must also be indefinite since the subject matter does not appear to be particularly pointed out and distinctly claimed.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 4, 12-15, 18-21, 34-37, 42, 43, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5,083,608 to Abdrakhmanov et al (the '608 patent).

Regarding claim 4, the '608 patent discloses a wellbore casing that comprises a first tubular member 2 having a first inside diameter, and a second tubular member 2 having a second inside diameter equal to the first diameter coupled to the first tubular in an overlapping relationship (see Fig. 5), wherein the first and second tubulars are coupled to one another, and wherein, prior to the coupling, the inside diameters of the first and second tubular members are not equal since the inside diameter of the first tubular at threads 4 is not equal to the inside diameter of the second tubular at threads 3 (see Fig. 5), and further wherein, prior to the coupling, the inside diameters of the first and second tubular members are substantially constant (again, see Fig. 5). It is also to be noted that this claim is of the product-by-process type, therefore the process by which the two tubulars are coupled together is irrelevant for this type of claim since the prior art discloses all of the limitations of the product being claimed.

Regarding claim 12, the '608 patent discloses a wellbore casing that comprises a first tubular member and a second tubular member coupled to the first tubular member in an overlapping relationship, wherein an inner diameter of the first tubular member is equal to an inner diameter of the second tubular member, wherein a portion of the first tubular member overlaps with a portion of the second tubular member, wherein the portion of the first tubular member that overlaps with the portion of the second tubular member comprises a thin walled

portion 4, and wherein the portion of the first tubular member that does not overlap with the portion of the second tubular member comprises a thick walled portion (see Figs. 5 and 6).

Regarding claim 13, the thin walled portion of the first tubular member comprises a compressible annular sealing member 31.

Regarding claims 14 and 15, the portion of the second tubular member that overlaps with the portion of the first tubular member comprises a thin walled portion 3, wherein the portion of the second tubular member that does not overlap with the portion of the first tubular member comprises a thick walled portion, and wherein the thin walled portion of the second tubular member comprises a compressible annular sealing member 31.

Regarding claims 18 and 20, the first tubular member overlaps with a portion of the second tubular member, wherein the portion of the first tubular member that overlaps with the portion of the second tubular member comprises a thin walled portion; and wherein the portion of the first tubular member that does not overlap with the portion of the second tubular member comprises a thick walled portion (see Figs. 5 and 6).

Regarding claims 19 and 21, the thin walled portion of both tubular members comprises a shared sealing member 31.

Regarding claims 34-37, the '608 patent discloses a wellbore casing that comprises a first tubular member having a first inside diameter; and a second tubular member having a second inside diameter equal to the first inside diameter coupled to the first tubular member in an overlapping relationship, wherein the first and second tubular members are coupled together, wherein a portion of the first tubular member overlaps with a portion of the second tubular member, wherein the portion of the first tubular member that overlaps with the portion of the

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second tubular member comprises a thin walled portion 4, wherein the thin walled portion of the first tubular member comprises a compressible annular sealing member 31, wherein the portion of the first tubular member that does not overlap with the portion of the second tubular member comprises a thick walled portion, wherein the portion of the second tubular member that overlaps with the portion of the first tubular member comprises a thin walled portion 3, wherein the thin walled portion of the second tubular member comprises a compressible annular sealing member 31 (it is noted that both thin walled portions share the same sealing member), wherein the portion of the second tubular member that does not overlap with the portion of the first tubular member comprises a thick walled portion, and wherein an inner diameter of the non-overlapping portion of the first tubular member is equal to an inner diameter of the non-overlapping portion of the second tubular member (see Figs. 5 and 6).

Regarding claims 42-43, the '608 patent discloses a wellbore casing that comprises a tubular member 2 including a thin wall section 3 at an end of the tubular member and a thick wall section adjacent to the thin wall section, and a compressible annular member 31 coupled to the thin wall section, wherein the compressible annular member extends substantially to the end of the tubular member, and wherein the outside diameter of the compressible annular member is greater than the outside diameter of the corresponding thin wall section when compared to the valleys of the threads, or wherein the outside diameter of the compressible annular member is less than the outside diameter of the corresponding thin wall section when compared to the peaks of the threads (see Figs. 5 and 6).

Regarding claim 45, the cross sections of the first and second tubular members are substantially circular (see Fig. 4).

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7. Claims 46-52 are rejected under 35 U.S.C. 102(e) as being anticipated by PCT WO 99/35368 to Lohbeck et al.

Regarding claim 46, Lohbeck et al disclose a method of forming a wellbore casing comprising forming a first tubular member 8 having a first portion comprising a first inside diameter and a second portion comprising a second inside diameter, wherein the second inside diameter is greater the first inside diameter (see Fig. 1 and page 7, line 5), positioning a second tubular member 9 within and in overlapping relation to the second portion of the first tubular member, and radially expanding and plastically deforming the overlapping portion of the second tubular member into engagement with the second portion of the first tubular member (see page 6, lines 26-34).

Regarding claims 47-50, the cross sections of the first and second tubular members are substantially circular, wherein, prior to the plastic deformation, the inside diameter of the second tubular member is substantially constant, and wherein, prior to the plastic deformation, the outside diameter of the second tubular member is less than the inside diameter of the first portion of the first tubular member (see Fig. 1 and page 6, lines 26-34).

Regarding claims 51-52, after the plastic deformation, the inside diameter of the plastically deformed overlapping portion of the second tubular member is equal to the inside diameter of the first portion of the first tubular member (see Fig. 1).

Claim Rejections - 35 USC § 103

8. Claims 2, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 5,957,195 to Bailey et al in view of the '608 patent.

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Bailey et al teach a wellbore casing comprising a tubular member including at least one thin wall section at an end of the tubular member and a thick wall section adjacent to the thin wall section, and wherein the thin wall section is not threaded (see Figs. 10C-E, G, and H). However, it is not expressly taught that a compressible annular member is coupled to each thin wall section or wherein the compressible annular member extends to the end of the tubular member.

The '608 patent teaches a wellbore casing similar to that of Bailey et al. It is further taught that a compressible annular member 31 is coupled to each thin wall section and wherein the compressible annular member extends to the end of the tubular member (see Figs. 5 and 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Bailey et al and the '608 patent before him at the time the invention was made, to modify the casing taught by Bailey et al to include the compressible member of the '608 patent, in order to obtain a sealed tubular joint. One would have been motivated to make such a combination since the '608 patent has shown it to be notoriously known in the art to use sealing members in between tubular joints so that reliability of the joint is increased (see col. 3, lines 35-38 of the '608 patent).

Regarding claim 16, the combination applied to claim 2 above teaches that the compressible annular member is coupled to an exterior surface of the thin wall section of the tubular member (see Figs. 5 and 6 of the '608 patent).

Regarding claim 17, the thin wall section of the tubular member is inherently plastically deformed (see the abstract and col. 1, lines 13-22 of Bailey et al, and col. 5, lines 10-34 of the '608 patent).

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9. Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lohbeck et al in view of Bailey et al.

Lohbeck et al teach the method of claims 46 and 50 that first and second tubular members coupled together in an overlapping manner. However, it is not expressly taught that overlapping portions of the tubular members have thin walled portions.

Bailey et al teach a method of forming a wellbore casing similar to that of Lohbeck et al. It is further taught that overlapping portions of the tubular members have thin walled portions (see Figs. 10C-E, G, and H). It would have been obvious to one of ordinary skill in the art, having the teachings of Lohbeck et al and Bailey et al before him at the time the invention was made, to modify the casing joints taught by Lohbeck et al to include the thin walled portions of Bailey et al, in order to obtain tubular joints that retain the same inner diameter throughout and are suitable for radial expansion. One would have been motivated to make such a combination since Bailey et al have shown it to be notoriously known in the art that tubular joints can have thin walled sections in the region of the joint to facilitate the connection.

Allowable Subject Matter

10. Claims 6, 8, 22-33, and 38-41 are allowed.

Response to Arguments

11. Applicant's arguments with respect to claims 2, 4, 12, and 34-37 have been considered but are moot in view of the new ground(s) of rejection. However, the rejection of claim 4, as amended, as being anticipated by Abdrakhmanov et al is still deemed valid because the inside diameters of the tubular members are not equal, as can be seen by comparing thin walled sections 3 and 4, which have different inner diameters.

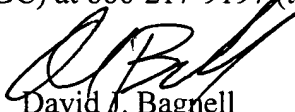
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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 7:00am to 4:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb 
July 11, 2005